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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,999	01/16/2002	Holger Klapproth	STURK 0002	6124

24203 7590 12/03/2004

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EXAMINER

CEPERLEY, MARY

ART UNIT

PAPER NUMBER

1641

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,999	KLAPPROTH, HOLGER	
	Examiner	Art Unit	
	Mary (Molly) E. Ceperley	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 20-23 is/are rejected.
- 7) ☒ Claim(s) 14-19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/3/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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1) Although specific claims are cited in the rejections below, these rejections are also applicable to all other claims in which the noted problems/language occur.

2) The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3) Claims 6, 8 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement and enablement requirements. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no written description in the specification of the proviso which appears in the last two lines of claim 21, i.e. "wherein when Z comprises a silane, X comprises a photocrosslinker; and wherein when Z comprises a photocrosslinker, X comprises a reactive group". There is also no enablement for the preparation and use of the compounds wherein "Z" or "X" is defined as "a photocrosslinker".

4) Claims 6, 8 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) In claims 6, 8 and 21-23 it is unclear what is meant by the term "photocrosslinker" as it appears in the last two lines of claim 21. It is unclear what moieties are "photocrosslinked" and the specification fails to provide any definition of the term "photocrosslinked". Also, the terms "Z" and "X" defined as "a photocrosslinker" at the end of the claim 21 is inconsistent with the earlier definitions of "Z" and "X" which do not include "a photocrosslinker".

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b) Claim 22 is indefinite and confusing for the reason that the reactive group "Z" is defined as being "capable of covalently binding to a biomolecule" but there is no requirement that "Z" be actually bound to the "biomolecule". Hence, step (b) requires that the surface which is terminated in a reactive group "Z" be "contacted" directly with a "sample"; it is unclear what interaction there is between the "contacted" functional moiety "Z" and the "sample" when no "biomolecule" is attached to "Z".

c) Claim 22 is indefinite and confusing for the reason that there is no requirement that the "sample" contain an analyte which specifically binds a "biomolecule" attached to the functional group "Z".

d) In claim 21, the definition of the last line "X comprises a reactive group" is redundant since "X" must always be a "reactive group" as defined earlier in the claim.

5) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6) Claims 7, 9-13 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by or obvious over GENSET (WO 95/01987) for the reasons stated in paragraph **10)** of the September 03, 2003 Office action.

Applicant's arguments filed September 15, 2004 have been fully considered but they are not persuasive. Applicant argues that GENSET is not applicable for the reason that the solid supports it discloses are used in nucleic acid synthesis methods rather than for specific binding analyses. However, this argument is irrelevant to the instant composition claims which are directed to surface-linker conjugates (claim 7) and surface-linker-biomolecule conjugates (claims 9-13). The compositions of both GENSET and the instant claims are the same independent of any intended method of use of the

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compositions. For a discussion of the features of the dependent claims, see paragraph **10)** of the September 03, 2003 Office action.

7) Claims 14-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary (Molly) E. Ceperley whose telephone number is (571) 272-0813. The examiner can normally be reached from 8 a.m. to 4:30 p.m.

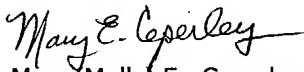
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le, can be reached on (571) 272-0823. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from

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either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 19, 2004


Mary (Molly) E. Ceperley
Primary Examiner
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